

REMARKS

This is a full and timely response to the Decision, noted above, and to the final decision of the Primary Examiner dated March 6, 2008 (the “final Office Action”). Reconsideration of the application in light of the above amendments and the following remarks is respectfully requested.

Claim Status:

Claims 26-45 and 59-70 were withdrawn from consideration under a previous Restriction Requirement and cancelled without prejudice or disclaimer. Claims 1-25, 46, 47, 50, 54 and 73-79 were also cancelled previously without prejudice or disclaimer.

In the present paper, claim 48 is cancelled without prejudice or disclaimer. Claim 49 is amended and rewritten as an independent claim, and all other claims have been amended accordingly. Thus, claims 49, 51-53, 55-58, 71, 72 and 80-90 are currently pending in the application.

Decision on Appeal:

The Decision reviewed the following grounds of rejection for the pending claims.

(1) Claims 48, 49, 51-53, 55-58, 71, 72 and 80-90 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

(2) Claims 48, 49, 51-53, 55-58, 71, 72 and 80-90 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

(3) Claims 48, 49, 51-53, 55, 57, 58, 71, 72 and 80-90 were rejected under 35 U.S.C. § 102(e) as anticipated by of U.S. Patent No. 7,086,732 to Kasperchik et al. (“Kasperchik”).

(4) Claims 48, 49, 51-53, 55, 57, 58, 71, 72, 80 and 86-89 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kasperchik, taken alone.

Of these grounds of rejection, the Decision reversed all the rejections with the following exceptions.

(1) The Decision affirmed-in-part the rejection of claims 49, 51-53, 55-58, 71, 72 and 80-90 under 35 U.S.C. § 112, second paragraph, as will be explained in detail below.

(2) The Decision affirmed the rejection of claims 48 and 87 as anticipated under 35 U.S.C. §102(e) by Kasperchik.

Claims 48, 49, 51-53, 55-58, 71, 72 and 80-90 were rejected under 35 U.S.C. § 112, second paragraph:

The final Office Action mentions a number of reasons for objecting to the claims under § 112, second paragraph. As this rejection was sustained in the Decision, Applicant addresses the issues raised as follows.

(1) Claim 48 recited “a first microporous layer comprising a first binder deposited as a liquid on said substrate.” The final Office Action argues that “[i]t is unclear whether said deposited liquid stays as a liquid or not on said substrate, and thus claims are indefinite.” (final Office Action, p. 3). In the Decision, this ground of rejection under § 112, second paragraph, was reversed. (Decision, p. 5).

Nevertheless, as this language is irrelevant to the subject matter held patentable in the Decision, the language in question has been deleted from the claims. Thus, the rejection under § 112, second paragraph, in this respect is moot.

(2) The final Office Action next argues that “[t]he recited preamble, ‘The microporous coating of ---’, in claims 49, 50-53, 55-58, 71, 72 and 80-90 lack a proper antecedent basis in claim 48 wherein ‘A print medium’ is claimed now.” (final Office Action, p. 3). In response, the preamble of all the claims has been amended for consistency with the remaining independent claim, claim 49. Therefore, following entry of this amendment, the rejection under § 112, second paragraph, in this respect, can be reconsidered and withdrawn.

(3) The final Office Action next argues that “[c]laims 81-84 are confusing and indefinite since they recited polymers (such as polystyrene) for a core material and monomers (such as n-ethylhexylacrylate) for a shell material. Consistency is needed.” (final Office Action, p. 3). In the Decision, this ground of rejection under § 112, second paragraph, was reversed. (Decision, p. 5).

(4) Finally, the final Office Action argues that the “recited ‘said shell material comprises a coalescing agent’ in claim 90 is confusing and indefinite since said coalescing agent is a solvent as taught by Kasperchik ... and a solvent cannot form a shell.” (final Office Action, p. 3). Applicant responds as follows. Claim 90 does not recite that the coalescing agent *alone* forms a shell. Rather, claim 90 merely recites that the “shell material comprises a coalescing agent.” (Claim 90). Clearly, a shell can comprise a material, such as a coalescing agent or a solvent that would not alone form a shell, but is still a constituent with other materials in a shell.

Consistent with this, in the Decision, this ground of rejection under § 112, second paragraph, was also reversed. (Decision, p. 8).

Claims 48 and 87 were rejected as anticipated under 35 U.S.C. §102(e) by Kasperchik:

In light of the Decision affirmation of this rejection, claim 48 has been cancelled in the present paper and claim 49, for which no rejection was sustained, has been made the sole independent claim in the application. Claim 87 and all other claims in the application now depend directly or indirectly from claim 49. Therefore, following entry of this amendment, the rejection of claims 48 and 87 based on Kasperchik is moot.

No other issues remain outstanding in this application.

Conclusion:

In view of the preceding arguments, all claims are believed to be in condition for allowance over the prior art of record. Therefore, this response is believed to be a complete response to the Decision. However, Applicant reserves the right to set forth further arguments in future papers supporting the patentability of any of the claims, including the separate patentability of the dependent claims not explicitly addressed herein. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed.

The absence of a reply to a specific rejection, issue or comment in the Office Action does not signify agreement with or concession of that rejection, issue or comment. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment. Further, for any instances in which the Examiner may wish to take Official Notice in the Office Action, Applicants expressly do not acquiesce to the taking of Official Notice, and

respectfully request that the Examiner provide an affidavit to support the Official Notice taken in the next Office Action, as required by 37 CFR 1.104(d)(2) and MPEP § 2144.03.

If the Examiner has any comments or suggestions which could place this application in better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

Respectfully submitted,

DATE: 15 November 2010

/Steven L. Nichols/
Steven L. Nichols
Registration No. 40,326

Steven L. Nichols, Esq.
Van Cott, Bagley, Cornwall and McCarthy PC
36 South State Street
Suite 1900
Salt Lake City, Utah 84111
(801) 237-0251
(801) 237-0853 (fax)
snichols@vancott.com